

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Hans-Michael EGGENWEILER et al.

Examiner: San Ming R. Hui

Serial No.: 10/750,878

Group Art Unit: 1617

Filed: January 5, 2004

Title: IMIDAZOLE DERIVATIVES AS PHOSPHODIESTRASE VII INHIBITORS

PETITION UNDER 37 C.F.R. §1.181

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a petition, under 37 C.F.R. §1.181, directing the Commissioner, through the Honorable Group Director, to direct withdrawal of the Requirement for Election, and complete examination of the present application.

(1) STATEMENT OF FACTS

On March 28, 2005, a Requirement for Election/Restriction was mailed to the applicant, in which it was stated that claim 5 was generic to a plurality of patentably distinct species "being administered for the claimed methods of use comprising compounds in which X represents oxygen or sulfur." In response to this requirement for election of species, applicants elected a single compound, and further a single method of use. Applicants timely traversed the requirement for restriction, arguing that once the compounds were found to be patentable, all the methods of use would be *per se* patentable, and there would be no additional burden to examine the full scope of the claims. Applicants requested that, if no prior art be found supporting a rejection

of the elected species, the search be extended to the full scope of the claim as mandated by Markush practice under M.P.E.P. §803.

On July 14, 2005, applicants received an Office Action on the merits, in which the only issued raised was a rejection under 35 U.S.C. §112. Applicants reiterated their traversal of the election of species, and responded to the §112 rejection.

On January 10, 2006, applicants received a final rejection not commenting upon their traversal of the restriction requirement, and reiterating the rejection under 35 U.S.C. §112. Applicants responded to the final rejection on June 12, 2006, again maintaining their traversal of the restriction requirement.

In an advisory action mailed July 5, 2006, the office argued (for the first time) that the claim was not "Markush-type." The advisory action thus maintained the restriction. Applicants have now timely filed this petition, concurrent with a brief on appeal.

(2) ARGUMENT IN SUPPORT OF REQUEST FOR RELIEF

It is respectfully submitted that the requirement for election of species fails to follow the proper procedure as set forth in M.P.E.P. §803.02, entitled "restriction-Markush claims." As noted above, no rejections over art have been made in the present application. The M.P.E.P. states that, if the Markush-type claim is *not allowable over the prior art* the examination will be limited to the Markush-type claim and in claims to the elected species. The M.P.E.P. continues that, "on the other hand, should no prior art be found that anticipates or renders obvious to the elected species, the search of the Markush-type claim will be extended." See §803.02. The M.P.E.P. clearly states that, whether or not the search and examination is to be extended, depends on patentability *over art*, not patentability under §112.

In the present situation, although no prior art has been cited, the search has not been extended beyond the elected species. It is respectfully submitted that this is improper. In the advisory action, it is apparently argued that the claims are not Markush-type claims, inasmuch as they do not "belong to a recognized physical or chemical class or to a art-recognized class." In support of this argument, the advisory action states that the *disorders* recited are recognized in the art as unrelated disorders. In fact, the M.P.E.P. addresses exactly such a situation, where

Markush-type generic claims recite a plurality of members which include independent and distinct inventions. The M.P.E.P. states that, following election, in the Markush-type claim will be examined fully with respect to the elected species and, as quoted above, if no prior art is found then the search will be extended. Thus, the argument in the advisory action that the indications recited in the claim are unrelated disorders is not seen to be relevant to the failure to extend the search and examination.

Moreover, it is submitted that the status of the members of the Markush group is unrelated disorders is also irrelevant to the propriety of the Markush group itself, which propriety is apparently advanced in the advisory action as a reason for maintaining the restriction requirement. Indeed, as set forth in M.P.E.P. §2173.05(h),

The materials set forth in the Markush group ordinarily must belong to a recognized physical or chemical class or to an art-recognized class. However, when the Markush group occurs in a claim reciting a process or a combination (not a single compound), it is sufficient if the members of the group are disclosed in the specification to possess at least one property in common which is mainly responsible for their function in the claimed relationship, and it is clear from their very nature or from the prior art that all of them possess this property. While in the past the test for Markush-type claims was applied as liberally as possible, present practice which holds that claims reciting Markush groups are not generic claims (MPEP §803) may subject the groups to a more stringent test for propriety of the recited members. Where a Markush expression is applied only to a portion of a chemical compound, the propriety of the grouping is determined by a consideration of the compound as a whole, and does not depend on there being a community of properties in the members of the Markush expression.

In the present application, the indications listed in the claim all do have at least one property in common which is mainly responsible for their function of the claim relationship. Indeed, all the indications listed are those which are treatable with PDE VII inhibitors. See, for example, the specification at page 3. Thus, this requirement set forth in the M.P.E.P. is met.

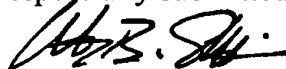
It is moreover important to note that not one, but two election of species requirements have been made in the present application. In addition to the election of a single method,

discussed at length above, the Office Action also required applicants to elect a single compound, which was done. In addition to failing to extend the search and examination to methods beyond the elected method, the Office Actions fail to extend the search and examination beyond the elected species of compound. No argument as to why such failure as appropriate has been made, the sole argument in the advisory action being directed to the methods. It is submitted that there is no reason why the search and examination has not been properly extended to compounds beyond the elected species.

In conclusion, it is submitted that ample basis to overturn the restriction requirement exists, and the same is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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